

REMARKS

Please note that the claim amendments provided above consist solely of modifying the language of the existing claims for the purpose of clarifying the language of the limitations of those claims. Consequently, no new matter has been added, and no new search is required.

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the Applicants hereby respectfully request further examination and reconsideration of the subject patent application.

1.0 Rejections Under 35 U.S.C. §112:

In the Office Action of May 8, 2003, claims 18-20 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. In particular, claim 18 was rejected as being unclear as to the meaning of the term “the weights” within the phrase “having weights that are at least equal to the weights.”

In response, the Applicants have amended claim 18 to clarify the claim language. In particular, Claim 18 now recites the following novel language:

“The method of claim 16 wherein entries are assigned relative weights, and wherein new entries having weights that are at least equal to the weights ***of existing entries in the list*** are added to the list to replace the existing entries.” (emphasis added)

Consequently, the rejection of claim 18, as amended, and of further dependent claims 19-20, under 35 U.S.C. §112 is no longer proper. Therefore, the Applicants

respectfully request reconsideration of the rejection of claims 18-20 under 35 U.S.C. §112 in view of the claim language cited above.

2.0 Rejections Under 35 U.S.C. §102(b):

In the Office Action of May 8, 2003, claims 48-53 were rejected under 35 U.S.C. §102(b), as being anticipated by Novell GroupWise 5.5 as supported by "GroupWise User's Guide for Windows 95/98/NT," (hereinafter "**GroupWise**"), and Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI."

A rejection under 35 U.S.C. §102(b) requires that the Applicants' invention was described in a printed publication more than one year prior to the date of application for patent in the United States. To establish that a patent describes the Applicants' invention, all of the claimed elements of an Applicants' invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(b) is not proper, as the Applicants' invention can be shown to be patentably distinct from the cited reference.

2.1 Rejection of Claim 48:

The Office Action rejected independent claim 48 under 35 U.S.C. §102(b) based on the rationale that the **GroupWise** reference discloses each of the elements of the Applicants' claimed "...method for automatically generating a dynamic list of entries containing contact information..." However, the Applicants respectfully traverse the rejection of claim 48 for the reasons discussed below.

In particular, the Office Action rejected claim 48 based on the rationale that, among other things, **GroupWise** teaches capturing addresses and contact information from **spreadsheet files**. In support of this rejection, the Office Action offers the "GroupWise 5.x & 6.x" article as teaching that **GroupWise** uses MAPI and that the article MAPI "shows in the second bullet on page 2 that MAPI can include spreadsheet

files.” The Office Action then continued by stating that **GroupWise** discloses extracting contact information from the scanned files. Apparently, the Office Action is suggesting here that the that **GroupWise** discloses automatically scanning spreadsheet files and extracting contact information from those spreadsheet files.

However, in contrast to the position advanced by the Office Action, the article MAPI, in the second bullet on page 2, reads in its entirety:

“Message Stores, which organize and store messages and allow them to be accessed. Messages are kept in folders, which are organized hierarchically. In addition, the user can alter messages and then put them back in their folders. ***A user who received a Microsoft Excel spreadsheet as an OLE object in a message, for example, could run Excel from within the message, modify the file, and then save the modified file as part of the message.***” (emphasis added)

Clearly the MAPI article refers to term “spreadsheet.” However, it should be clear from the context of the cited text that spreadsheets are **not** automatically scanned by **GroupWise**. In fact, the **GroupWise** MAPI article is simply explaining that objects such as spreadsheet files embedded within email messages can be accessed and modified by a user, and then resaved as a part of that email message. Therefore, it should be clear that unlike the Applicants’ claimed invention, **GroupWise** simply does **not** teach, and in fact, is **not** capable of scanning spreadsheet files and populating a contact list with information extracted from such spreadsheet files.

Further, it should be noted that paragraph 14 of the Office Action discussed the Applicants previous arguments with respect to claim 48 directed to the types of files that are scanned in the data store. In particular, the Office Action suggested that while the Applicants recited a number of file types to be included in the data store, the Applicants did not explicitly claim that each type of file in the data store be scanned and contact information extracted from files other than email files. The Applicants believe that the

claim language clearly indicates that contact information is extracted from any scanned files, of whatever type, in the data store. However, to address this concern that has been raised, claim 48, as well as independent claims 1 and 32, have been amended to specifically recite that any of the files of the various enumerated types in the data store are scanned, and that contact information is extracted from any of those file types.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 48, has elements not taught in the **GroupWise** reference. Consequently, the rejection of claim 48 under 35 U.S.C. §102(b) is not proper. Therefore, the Applicants respectfully traverse the rejection of claim 48, and of further dependent claims 49-53. Thus, the Applicants respectfully request reconsideration of the rejection of claims 48-53 under 35 U.S.C. §102(b) in view of the claim language of claim 48 which includes the following novel language:

“A method for automatically generating a dynamic list of entries containing contact information comprising:

scanning any of a plurality of file types in a data store containing electronic files including emails and any of word processor files, spreadsheet files, database files, and presentation files;

extracting contact information from any of the scanned files; and
populating the list with the information extracted from the scanned files.” (emphasis added)

3.0 Rejections Under 35 U.S.C. §103(a):

In the Office Action of May 8, 2003, claims 1-3, 5-17, 21-22, 24-36, 38-43 and 45-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **GroupWise** and the Novell articles entitled “GroupWise 5.x & 6.x” and “MAPI” in view of Atlas, et al, (“**Atlas**,” U.S. Patent No. 6,208,309).

In order to deem the Applicants' claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicants' invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

3.1 Rejection of Claims 1 and 32:

With respect to independent claims 1 and 32, the Office Action rejected these claims under 35 U.S.C. 103(a) based, in part, on the rationale that although the ***GroupWise*** reference "does not explicitly describe automatically weighting each entry," the ***Atlas*** reference "describes a method of auto completing entries in a field ... weights the entries by frequency of use or most recently used (col. 4, lines 16-20) and presents specific (most probable) entries ... based on the weight of each entry in the list (col. 4, lines 55-60)." The Office Action then continues by suggesting that it "would have been obvious to one of ordinary skill in the art to modify the contact resolution method of GroupWise to automatically give more weight to the most frequently (or recently) used

entries in the list and provide specific entries based on the weight of each entry as supported by Atlas.”

In contrast to the position advanced by the Office Action, the text of **Atlas** cited by the Office Action, col. 4, lines 16-20, and col. 4, lines 55-60, appears to describe the use of various sorting methods. For example, col. 4, lines 16-20 states that “autocomplete may be based on a variety of standard functions such as completely alphanumerical ascending or descending **sort**, frequency , recentness, etc.” (emphasis added). Similarly, col. 4, lines 55-60 states “the order of display, e.g. based on frequency or completely alphabetically, whether single or multiple proposed entries for the field are presented and how items are to be added to the database or library which provides proposed entries.” Clearly, both of the cited sections describe methods for **sorting** entries, rather than **weighting** entries. In fact, while the term “**sort**” is mentioned in the **Atlas** reference, the term “**weight**” or “**weighting**” or any other analogous term is never mentioned, suggested, or in any way described by the **Atlas** reference.

There is a clear difference between **weighting** entries in a list and **sorting** those entries. Note that the Applicants have amended claim 1 to make it more clear that entries in the list are being **weighted** rather than **sorted**. Specifically, the Applicant has amended claims 1 and 32 to replace the terms “**weighting**” with the term “**computing a weight**,” and “**weight**” with the term “**computes a weight**,” respectively. These amendments are fully supported by the specification, and are meant to further clarify the meaning of the claims rather than to change their scope. For example, the Applicants describe the idea of weighting entries on page 16, lines 26 through 31 of the specification as follows:

“Weight may be calculated using many different parameters, however, the parameters which are preferably used to calculate weight include the number of times that the email address or contact has been used for either sending or receiving (N_u), the number of days since the address

was last used in a send operation (N_s), and the number of days since the address was used for a receive operation (N_r)."

Similarly, on page 22, lines 6-12 of the specification, the Applicants further describe the weighting process as follows:

"Each address can be assigned a weighting value determined by 1) whether the address was sent to (higher weighting) or received from (lower weighting); 2) the number of times the message has been sent to/received from; and 3) the frequency of sending/receiving (i.e. number of messages divided by the time that has passed between the first message and the current time)."

Clearly, in view of the above cited text, the Applicants are **computing** weights based on a **combination of a plurality of factors**. In contrast, **Atlas** appears to merely describe the use of individual factors for **sorting** entries. Consequently, it should be clear that neither **Atlas** nor **GroupWise** actually weights entries in the list, nor do they in any way describe **computing weights** for those entries. In particular, in contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the **sorting** described by **Atlas** is not a **weighting** of the entries, and that in fact, such **sorting**, being based on individual factors such as frequency of use, does not teach **computing a weight** for such entries. For example, *Webster's Encyclopedic Unabridged Dictionary of the English Language*, Copyright 1996, Random House Value Publishing, Inc., (hereinafter "**Webster's**") defines the term "sort" as "to place (records) in order, as numerical or alphabetical, based on the contents of one or more keys contained in each record." In contrast, **Webster's** defines "weight" in the sense offered and described by the Applicants as "a measure of the relative importance of an item in a statistical population."

Therefore, it should be clear that **Atlas** sorts entries in the list for presentation in its "autocomplete" function using **one** of several methods, including ascending or

descending alphanumeric sorting, or sorting of entries based on frequency of use, or recentness of use. These **Atlas** sorting methods are clearly convenient conventional methods for sorting entries. However, while useful, they do not in any way suggest that a **weight** is computed for particular entries using a combination of a plurality of factors, with such weight providing “a measure of the relative importance of an item in a statistical population” as do the Applicants. It should be clear that merely keeping track of information such as when an entry was last used is **not** the same thing as computing a weight for an entry. Again, as discussed above, it should be clear that **Atlas sorts** entries based on a single factor while the Applicants **compute weights** for entries based on a plurality of factors.

Consequently, the Applicants respectfully suggests that each of the **Atlas** alphabetical sorts, frequency sorts, and recentness sorts, fails to teach the Applicants’ weighting of entries as described by independent claims 1 and 32. Further, as admitted by the Office Action, the **GroupWise** reference “does not explicitly describe automatically weighting each entry.” Consequently, the Applicants respectfully suggest that claim 1 and claim 32, as amended, each include elements not taught by the proposed **GroupWise - Atlas** combination.

Therefore, it can be seen from the preceding discussion that the rejection of independent claim 1 and independent claim 32 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise - Atlas** combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that rejected claim 1, and thus dependent claims 2-3, 5-17, 21-22, and 24-31 are patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claims 1-3, 5-17, 21-22, and 24-31 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, which includes the following novel language:

“An electronic contact resolution method, comprising:
 automatically extracting contact information from any of a plurality
of file types included in a data store;
 maintaining a list of at least one contact entry derived from the
contact information extracted from the data store;
 automatically weighting each entry in the list,
 tracking contact information associated with the contact entry; and
 automatically resolving contact entries in real time by dynamically
providing specific contact entries from the maintained list ***based on the
weight of each entry in the list.***” (emphasis added)

Similarly, this lack of a prima facie showing of obviousness means that rejected claim 32, and thus dependent claims 33-36, 38-43 and 45-47 are patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claims 32-36, 38-43 and 45-47 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 32, which includes the following novel language:

“A system for automatically generating a dynamic list of entries containing contact information comprising:
 a data store comprising electronic files;
 a scan module that scans any of a plurality of file types included in the data store;
 an extract module that extracts contact information from any of the scanned files;
 a populate module that populates the list with the information extracted from the scanned files; and
 a weight module that ***dynamically computes a weight for each entry in the dynamic list.***” (emphasis added)

3.2 Rejection of Claims 3 and 33:

With respect to dependent claims 3 and 33, the Office Action rejected these claims under 35 U.S.C. 103(a) based, in part, on the rationale that the **GroupWise** reference teaches that “the data store has a plurality of types of electronic files, including sent and received e-mail.” As noted above with respect to the rejection of claim 48, the **GroupWise** reference does teach the use of sent and received emails in the data store. However, unlike the Applicants’ claimed invention, **GroupWise** simply does **not** teach, and in fact, does **not** appear to be capable of scanning other types of electronic files, such as “word processor files, spreadsheet files, database files, and presentation files.”

Note that paragraph 14 of the Office Action discussed the Applicants previous arguments directed to the types of files that are scanned in the data store. In particular, the Office Action suggested that while the Applicants recited a number of file types to be included in the data store, the Applicants did not explicitly claim that each type of file in the data store be scanned and contact information extracted from files other than email files. However, to address this concern, claims 1 and 32, as well as claim 48, have been amended to specifically recite that any of the files of the various enumerated types in the data store are scanned, and that contact information is extracted from any of those file types.

Therefore, it can be seen from the preceding discussion that the rejection of dependent claim 3 and dependent claim 33 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise - Atlas** combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that rejected claim 3 is patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claim 3 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of dependent claim 3, which includes the following novel language:

"The method of claim 2 wherein the data store further includes a plurality of electronic documents including one or more of **word processor files, spreadsheet files, database files, and presentation files.**" (emphasis added)

Similarly, this lack of a prima facie showing of obviousness means that rejected claim 33 is also patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claim 33 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 33, which includes the following novel language:

"The system of claim 32 wherein the data store has a plurality of types of electronic files, including:

- at least one of previously sent and received email;
- email addresses and contacts that exist within previous systems;
- email stores located on public servers;
- current and previous contact databases; and
- data embedded within application electronic files, including any of

word processor files, spreadsheet files, database files, and presentation files." (emphasis added)

4.0 Additional Rejections Under 35 U.S.C. §103(a):

In the Office Action of May 8, 2003, claims 23 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over **GroupWise, Atlas** and Goodhand et al. ("**Goodhand**," U.S. Patent No. 5,923,848). However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claim 23, and independent claim 32 which is the parent claim of claim 44, the **GroupWise - Atlas** combination fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to

be patentable over the cited art. Thus, because claims 1 and 32 have been shown to be patentable over the **GroupWise - Atlas** reference, dependent claims 23 and 44, respectively, must also be patentable over the proposed **GroupWise - Atlas - Goodhand** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 32, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 23 and 44 under 35 U.S.C. §103(a) over **GroupWise, Atlas**, and **Goodhand** in view of the non-obviousness of claims 1 and 32, respectively.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-3, 5-36 and 38-53 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-3, 5-16, 21-23, 26-36 and 39-53, and objection to claims 17-20, 24, 25, and 38, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



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